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Application Number	10/658,804
Filing Date	September 9, 2003
First Named Inventor	Sayeed Ahmed
Art Unit	2838
Examiner Name	Gary L. Laxton
Attorney Docket No.	130209.508

ENCLOSURES (check all that apply)

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
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Signature		
Printed Name	Timothy L. Boller	
Date	November 2, 2006	Reg. No. 47,435

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Sayeed Ahmed et al.
Application No. : 10/658,804
Filed : September 9, 2003
For : TRI-LEVEL INVERTER

Examiner : Gary L. Laxton
Art Unit : 2838
Docket No. : 130209.508
Date : November 2, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents:

In the Restriction Requirement dated October 6, 2006, the Examiner restricted the application into:

Group I, including claims 1-3, 11-14 and 17-19, described by the Examiner as drawn to a power module with AC and DC terminals and wherein the inverter is configurable to selectively switch between three output states, classified in class 363, subclass 98;

Group II, including claims 4-10, described by the Examiner as drawn to an inverter with nodes, transistors coupled to the nodes, control signals and diodes in parallel to the transistors, classified in class 363, subclass 132; and

Group III, including claims 15 and 16, described by the Examiner as drawn to an inverter with three nominal output voltage levels and means for externally coupling the inverter to first, second, and third loads, classified in class 307, subclass 11.

Election of Group I.

In the event that the restriction is NOT withdrawn, Applicants hereby elect Group I for examination at this time, and respectfully traverse the Restriction Requirement for the reasons stated below. Applicants' election of Group I specifies claims 1-3, 11-14 and 17-19.

Restriction Can Be Proper In Limited Circumstances.

An application may properly be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either *independent* or *distinct*. If a search and examination of an entire application can be made *without serious burden*, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803. In referring to practice under 35 U.S.C. 121, the MPEP notes “it becomes very important that the practice under this section be carefully administered,” and goes on to state “IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.” MPEP 803.01 (Emphasis in original.) The concern is that the public should be able to rely on the assumption that upon expiration, the public will be free to use not only the invention claimed in the patent, but also modifications and variants thereof. MPEP 804.

The Examiner Has Failed To Establish A Serious Burden.

“Every requirement to restrict has two aspects: (A) the reasons … why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required … .” (Emphasis Added.) MPEP 808. “Where the related inventions as claimed are shown to be … distinct …the examiner … must explain why there would be a serious burden on the examiner if restriction is not required.” (Emphasis Added.) MPEP 808.02.

The Examiner’s sole stated support for a serious burden is that the inventions are in separate classifications, which the Examiner relies on to conclude that the inventions have a separate status. The Examiner classified Claim Groups I and II in the same class, each classified in class 363, with Claim Group I in subclass 98 and Claim Group II in subclass 132. The Examiner has classified Claim Group III in class 307, subclass 11.

Applicants’ Attorney is unable to discern how searching the entire application would present a *serious burden* to the Examiner. By entering the Restriction Requirement, the Examiner is contending that while searching the power module with an inverter configurable to switch between three output states (i.e., claim 1) in art class 363, subclass 98, he would not also search subclass 132, that covers an inverter comprising three phase circuits (i.e., claim 7).

Likewise, the Examiner would not search the art class 307, subclass 11, covering an inverter with three nominal output voltage levels.

From past experience, it is likely that in addition to art classes encompassing power module structures, the Examiner will look to art classes covering inverters, and *will* rely on references from such a class to reject the claims directed to the power module structure. Accordingly, Applicants respectfully submit that searching the entire application will not present a serious burden to the Examiner and request that the Restriction Requirement be withdrawn.

Summary.

In making the above arguments, Applicants do not admit that any of the independent claims are obvious in light of one another. Applicants further do not admit that such classes are appropriate for search, should the Examiner persist in the Restriction Requirement. In light of the foregoing remarks, Applicants respectfully request that the Restriction Requirement be withdrawn and all pending claims examined.

Respectfully submitted,
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